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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/307, 195 05/07/99 COHN

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THOMAS O HOOVER ESQ  
HAMILTON BROOK SMITH & REYNOLDS PC  
TWO MILITIA DRIVE  
LEXINGTON MA 02421-4799

EXAMINER

SMITH, J

ART UNIT

PAPER NUMBER

3732

4

DATE MAILED:  
10/04/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. <b>09/307,195</b>	Applicant(s) <b>Cohn</b>
	Examiner <b>Jeffrey A. Smith</b>	Group Art Unit <b>3732</b>

- Responsive to communication(s) filed on \_\_\_\_\_.
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- Claim(s) 1-50 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) 1-50 is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been
- received.
  - received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

- Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- Notice of References Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- Interview Summary, PTO-413
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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**DETAILED ACTION**

***References cited in Parent***

The references cited in parent application 08/845,333 are cited in this Office Action. However, copies of such references are not being transmitted to Applicant.

***Specification***

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Particularly, Applicant's cooperation in ensuring cross-correspondence between reference numerals in the specification and figures is appreciated.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 6, 7, 9-13, 22, 35, 38, 42, 43, 45, 47-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 6, 10, 12, and 13: the scope of these claims is unclear since Applicant positively recites the connector which is only inferentially set forth in the base claim of these respective claims.

In claim 9: this claim should be written to depend from claim 8 rather than itself.

In claims 11 and 35, lines 2, respectively: "retractor" should read as --retaining element--.

In claim 22, line 1: "the connecting step" lacks antecedent basis in claim 18. This claim should be written to depend from claim 19.

In claim 38, last line: "hold" should read as --holder--.

In claims 42 and 47, lines 1, respectively: "element" should read as --base--.

In claim 43, line 2: "element" should read as --base--.

In claim 45, line 1: "the cord" lacks antecedent basis.

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In claim 48, line 1: "the compression surface" lacks antecedent basis in claim 41. This claim should be written to depend from claim 47.

In claim 50, line 2: "retractor" should read as --retaining base--.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-3, 5-10, 12-14, 16, 18, 19, 22, 24-27, 29-34, 36, 41, 42, and 44-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Benetti et al. (U.S. Patent No. 5,894,843).

Benetti et al. discloses (Fig. 7) a surgical device (60) comprising a retaining element (62) having an aperture (61); a plurality of suture holders (70); a handle (69); and a tab (63). A method including the steps of positioning, occluding, and connecting are disclosed (col. 12, lines 5-27).

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4, 11, 17, 21, 28, 35, 43, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benetti et al. (U.S. Patent No. 5,894,843).

Although Benetti et al. does not disclose irrigation or suction, it would have been obvious to one of ordinary skill in the art to have provided the device reported above to have included such structure because the use of irrigation and suction are well-known for use during surgeries of the type disclosed by Benetti et al.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

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Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-50 are rejected under the judicially created doctrine of double patenting over claims 1-65 of U. S. Patent No. 6,033,362 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

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***Allowable Subject Matter***

Notwithstanding the Double Patenting rejection:

Claims 15, and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 38 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action.

Claims 37, 39, and 40 are allowed.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The additional references cited disclose various features which are similar to those disclosed by Applicant.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Smith whose telephone number is (703) 308-3588.



Jeffrey A. Smith  
Primary Examiner  
Art Unit 3732

jas  
October 2, 2000